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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,801	11/26/2003	Joseph M. Steigerwald	ITL.0947US (P15971)	8208
21906	7590	04/19/2005		EXAMINER
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			CLARK, SHEILA V	
			ART UNIT	PAPER NUMBER
			2815	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/722,801	STEIGERWALD, JOSEPH M.
	Examiner S. V. Clark	Art Unit 2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 January 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1, 5-12 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 5-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- Notice of References Cited (PTO-892)
- Notice of Draftsperson's Patent Drawing Review (PTO-948)
- Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- Notice of Informal Patent Application (PTO-152)
- Other: \_\_\_\_\_

Claims 1, 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites in the last line that "said electrodes are of opposite contact to said contact". But no physical contact structure (" said contact") has been recited in the claim. It is therefore unclear what is meant in claims by "said contact". Provision of the "electrical contact" in line 4 of the claims can have many different variations from allowing the conductive wafer to electrically touch the conductive surface of the pad or to providing other external electrical stimuli. The specification on for example page 4 recites that film 22, which is taught to be a conductive film is one polarity and the counter electrode 16 is another polarity but the conductive film 22 has not been claimed and has technically not been identified as being of "opposite polarity". The only specific recitation of "opposite polarity" is recited page 4, line 16 with regard to a potential of "opposite polarity" applied to the platen 14. The amendments to claim 1 therefore lack clarity. The other claims which are dependent on claim one have also been identified in the grouping.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 in so far as definite are rejected under 35 U.S.C. 103(a) as being unpatentable over Emesh et al (6,802, 955) including the incorporated teachings of Breivogel et al (5, 554, 064)

Emesh et al shows in for example figure 9 a wafer 904 positioned on a conductive polishing pad 612. The provision of electrical contact to the surface of the pad is taught in col. 9, lines 9-35. The teachings of Emesh is deemed to obviously include the steps of positioning and providing.

Col. 9, lines 25-30 discusses applying a positive and negative charge ( first and second potential of a first and second polarity).

Figure 10 shows circular shaped openings 708 in the pad.

Col. 7, line 13 of Emesh teaches use of pressure ( i.e. surface tension) and the Breivogel teachings (incorporated into Emesh reference, see col.9) further teach applying pressure in col. 4, line 32-45 and counter rotating in col.4, line 28. as well as the use of abrasives or slurries ( see col.4, lines 57-62).

Claims 1-12 are rejected.

Applicant's arguments filed 1-28-2005 have been fully considered but they are not persuasive. Applicant remarks that the polishing pad of 612 of Emesh is not conductive because it is made of insulating material. Col.8, lines 50-54 teach that said polishing pad is provide with a plurality of conductive regions made from conductive polymer as well as exposure to an electrolyte solution and therefore rendering it conductive

Also the instant claims as noted above have not recited that the pad and the electrodes are of opposite polarity and the instant specification only appears to discuss "opposite polarity" relative to an electric potential. The instant claims also attempts to recite the invention in as broad of terms as possible when the inventive features of the invention appear to be in the details that fail to be recited.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to S. V. Clark at telephone number (571) 272-1725.

  
S. V. Clark  
Primary Examiner  
Art Unit 2815

April 16, 2005